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In re Application of :
BOSE *et al* :
U.S. Application No.: 10/560,285 :
PCT No.: PCT/US2004/018435 :
Int. Filing Date: 10 June 2004 :
Priority Date: 12 June 2003 :
Attorney Docket No.: 003433.00096 :
For: BUSINESS PROCESS AUTOMATION :

DECISION

This decision is in response to applicants' "Petition Under 37 C.F.R. §1.47(a)" filed 31 August 2007.

BACKGROUND

On 31 January 2007, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge fee was required. Applicants were given two months to respond with extensions of time available.

On 31 August 2007, applicants filed the instant petition which was accompanied by, *inter alia*, the petition fee; a five-month extension and fee; the surcharge fee; a declaration executed by four of the seven joint inventors; and exhibits A - K.

DISCUSSION

Applicants claim that three of the seven named inventors either refuse to cooperate, or cannot be located. As such, a petition under 37 CFR 1.47(a) was submitted in response to the Form PCT/DO/EO/905 mailed 31 January 2007.

A petition under 37 CFR 1.47(a) requires: (1) the petition fee; (2) factual proof that the missing joint inventor cannot be located or refuses to cooperate; (3) a statement of the last known address(es) of the nonsigning joint inventor(s); (4) and an oath or declaration executed by the signing joint inventor(s) on their behalf and on behalf of the nonsigning joint inventor(s).

Concerning item (1), the \$200.00 petition fee has been paid.

With regards to item (3), two addresses for each of the three nonsigning inventors were provided in the petition. This meets the requirements of § 409.03(e) MPEP and is sufficient to satisfy item (3).

Concerning item (4), the 37 CFR 1.47(a) applicant submitted a declaration signed by four of the seven named inventors on their own behalf and on behalf of the nonsigning joint inventors. This declaration meets the requirements of section 409.03(a) and is in compliance with 37 CFR 1.497(a) and (b).

Thus, items (1), (3) and (4) of 37 CFR 1.47(a) are satisfied.

Regarding item (2), for co-inventor, Subhra Bose, the 37 CFR 1.47(a) applicants claim that a complete copy of the subject application was provided to two different addresses on 08 February 2006 and on 07 April 2006. There is evidence that Mr. Bose received the mailing by FedEx on 10 April 2006. See Exhibit D. Moreover, the 37 CFR 1.47(a) applicants have attempted to contact Mr. Bose using the telephone but have been unsuccessful. The 37 CFR 1.47(a) applicants state that they have not received any communication from Mr. Bose as of 31 August 2007.

Section 409.03(d) of the MPEP discusses a refusal by an inventor to cooperate and states, in part:

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney . . .

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted.

The evidence provided is sufficient to conclude that certain papers were received by Mr. Bose on 10 April 2007. However, the 37 CFR 1.47(a) applicants failed to provide a copy of the cover letter for those documents. As such, there is no direct evidence that a complete copy of the subject application was received by Mr. Bose. A copy of this cover letter should be provided in any renewed petition. Moreover, the 37 CFR 1.47(a) applicants should also submit documentary evidence that a search of the telephone number of Mr. Bose was performed in any renewed petition.

Regarding item (2), for co-inventor, Ziyang Duan, the 37 CFR 1.47(a) applicants claim that two letters containing a copy of the subject application were mailed to two different addresses on 07 February 2006 and 07 April 2006. However, both packages were returned as undeliverable. Petitioners have been unable to contact Mr. Duan any other way.

Applicants' burden in showing that an inventor cannot be located is also explained in section 409.03(d) of the MPEP which states, in part:

Where inability to find or reach a nonsigning inventor 'after diligent effort' is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included in the statement of facts. It is important that the statement contain facts as opposed to conclusions.

In this case, petitioners submitted a statement of facts as required. However, petitioners have not made a showing that a diligent effort was made to locate the nonsigning inventor. The people finder search result alone is not sufficient to make such a showing. The 37 CFR 1.47(a) applicants must conduct a search for Mr. Duan and provide documentary evidence(such as internet/telephone searches etc.) in any renewed petition.

Regarding item (2), for co-inventor, Radu Grosu, the 37 CFR 1.47(a) applicants claim that a letter was mailed to the Rocky Point, NY address on 07 February 2006 but was returned as undeliverable. Petitioners then state that they have obtained a business address at Stony Brook University for Mr. Grosu. Petitioners submitted a copy of the subject application on 09 March 2008. The package was signed for by K.

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Germana. However, there is no evidence that it was received by Mr. Grosu. Petitioners have also had no luck in reaching Mr. Grosu at his business telephone number as the mail box was full.

Here, there is no direct evidence that Mr. Grosu received a copy of the subject application. Hence, this is also treated as the inventor cannot be located. Therefore, the 37 CFR 1.47(a) applicants should also submit documentary evidence of all searches for Mr. Grosu as indicated above in any renewed petition.

For the reasons noted above, petitioners have not yet satisfied item (2) of 37 CFR 1.47(a) for any of the nonsigning inventors.

CONCLUSION

Applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. No additional petition fee is required.

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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